

REMARKS**I. General**

Claims 1, 3-6, 8-13, 15-22, 24-27, and 29-53 remain pending in the present Application, but in the Current Action, the Examiner again rejects claims 1, 3-6, 8-13, 15-22, 24-27, and 29-37 under 35 U.S.C. § 103. The Applicant respectfully asks the Examiner to withdraw the outstanding rejections in light of the arguments contained herein.

II. The 35 U.S.C. § 103 Rejections

Claims 1, 3-6, 8-13, 15-22, 24-27, and 29-53 remain rejected under 35 U.S.C. § 103(a), for being unpatentable over Caporizzo et al., patent number 6,014,547 (hereinafter *Caporizzo*), in view of Yamashita et al., patent number 4,419,768 (hereinafter *Yamashita*). In the Response dated October 23, 2003 (paper No.16) (hereinafter "Previous Response"), the Applicant reminded the Examiner that in order to establish a *prima facie* case of obviousness, a rejection must meet three basic criteria, see M.P.E.P. § 2143. First, it must cite some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, the proposed combination or modification must have had some reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the limitations found in the rejected claims. Without conceding the second criteria, the Applicant again respectfully asserts that the Examiner has failed to indicate a proper motivation for combining of *Caporizzo* and *Yamashita*. Further, the Applicant again asserts that even if combined as the Examiner proposes, the combination of applied art fails to teach or suggest all of the limitations in the rejected claims.

A. The Limitations of Independent Claims 1 and 32 are not Met by *Caporizzo* and *Yamashita*

As the Applicant demonstrated in the Previous Response, the combination of *Caporizzo* and *Yamashita* does not teach all of the limitations of claims 1 and 32.

Specifically, claim 1 recites:

means for determining from a measurement of the
measurable characteristics which are present in a particular set

of signals input to said tuner certain tuner operating characteristics; and

means operable under control of said determining means for . . . changing power consumption levels with respect to certain of said tuner components to meet desired tuner output characteristics when processing said specific signals

Accordingly, the invention of claim 1 provides for changing power consumption levels with respect to certain of the tuner components, to meet desired tuner output characteristics when processing specific signals, under control of a means for determining those tuner operating characteristics from measurements of signals input to the tuner.

Caporizzo does not teach the invention of claim 1, because, among other things, *Caporizzo* fails to teach changing power consumption levels with respect to tuner components to optimize a tuner power level; a point the Examiner concedes in both the Current Action and the Action mailed July 24, 2003 (paper 15) (hereinafter “Previous Action”). In an attempt to cure this defect, the Examiner combines *Caporizzo* with *Yamashita*, which the Examiner contends discloses a tuner which is controlled to reduce power consumption by switching to UHF channels to optimize to a level sufficient to compensate the loss introduced to tuning components. However, as the Applicant demonstrated in the Previous Response, even if these references are combined as the Examiner desires, they still do not teach all of the limitations of claim 1. *Caporizzo* teaches that “equalizer 50 compensates for the difference in the signal level between the lower frequencies and the higher frequencies by attenuating the frequencies having a higher signal level to the same level as the frequencies having a lower signal level,” column 3, lines 2-6. *Yamashita* teaches that when a switch is moved to the “[UHF] mode, the active circuits of the CATV tuning section 200 are de-energized to disable the operation thereof,” column 4, lines 47-49. Therefore, even if one of ordinary skill in the art were to modify the power-up equalization technique of *Caporizzo* to include the tuning section de-energizing technique of *Yamashita*, the resulting combination would merely provide a system in which portions of the signal band will be equalized independent from de-energizing a CATV tuning section when a UHF mode selector switch is activated. Nothing in this combination changes power consumption levels of tuner components to meet desired tuner output characteristics which are determined from measurements of signals input to the tuner. Indeed, in the combination

of *Caporizzo* and *Yamashita*, there is no interaction between the power-up signal equalization and the tuner component de-energizing whatsoever.

In the Current Action, the Examiner has responded to the Applicant's argument by opining that "the mere fact that applicant has recognized another advantage, which would, [sic] flow naturally from the following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." However, the Applicant respectfully points out that the Previous and Current Response do not contend that claim 1 is patentable because the proposed combination fails to disclose all of the claim's advantages, but rather Applicant asserts that claim 1 is patentable because the proposed combination fails to teach or suggest all of the claim's limitations; an assertion unchallenged by the Current Action. Accordingly, claim 1 and the claims dependent therefrom are patentable over the 35 U.S.C. § 103 rejection of record, and the Applicant respectfully asks the Examiner to withdraw that rejection.

Claim 32 recites:

determination circuitry for identifying which signal set is being processed at a point in time and determining an appropriate power level for each of a plurality of tuner components of said tuner for processing said signal set; and
adjustment circuitry operable in cooperation with said determination circuitry for implementing said power levels with respect to said tuner components in accordance with the signal set then being processed.

Accordingly, the invention of claim 32 provides for determining appropriate power levels for a plurality of tuner components, cooperating with signal set identifying circuitry, for processing an identified set of signals. The Examiner's proposed combination does not teach all of the above limitation, because in part, neither *Caporizzo* nor *Yamashita* teach or suggest determining an appropriate power level for each of a plurality of tuner components used in processing an identified signal set, and adjustment circuitry for implementing the determined power levels. Moreover, as demonstrated in the Previous Response and as discussed above with respect to claim 1, the combination of *Caporizzo* and *Yamashita* proffered in the Office Action does not provide the requisite interaction between determination circuitry and adjustment circuitry as set forth in claim 32. Therefore, the

combination of *Caporizzo* and *Yamashita* does not teach or suggest every limitation of claim 32.

As with claim 1, the Examiner responds to these arguments by opining in the Current Action that “the mere fact that applicant has recognized another advantage, which would, [sic] flow naturally from the following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” However, the Applicant again respectfully points out that the Previous and Current Response do not contend that claim 32 is patentable because the proposed combination fails to recite all of the present invention’s advantages. Rather the Applicant has asserted, and does so again, that claim 32 is patentable because the proposed combination fails to teach or suggest all of that claim’s limitations; an assertion unchallenged by the Current Action. Accordingly, claim 32 and the claims dependent therefrom are patentable over the 35 U.S.C. § 103 rejection of record, and Applicant respectfully asks the Examiner to withdraw that rejection.

B. The Limitations of Independent Claims 6, 9, 18, and 26 are not Met by *Caporizzo* and *Yamashita*

As the Applicant demonstrated in the Previous Response, the combination of *Caporizzo* and *Yamashita*, even if proper, does not teach or suggest all of the limitations of claims 6, 9, 18 and 26 either.

Specifically, Claim 6 recites:

assessing . . . the incoming signal environment . . . ;
based upon said assessed incoming signal environment
selecting an operating level for said tuner, wherein said
selecting step includes the step of selecting an optimum power
consumption level for said tuner

Accordingly, the invention of claim 6 provides for selecting an optimum power consumption level for the tuner based upon an assessed incoming signal environment. As demonstrated in the Previous Response, the proposed combination of references does not teach or suggest all of the above limitations. As demonstrated above, the combination proposed by the Examiner results in portions of the signal band being equalized independent from de-energizing a CATV tuning section when a UHF mode selector switch is activated. Nothing in this combination teaches or suggests selecting an optimum power consumption

level for the tuner based upon an assessed incoming signal environment, thus the combination does not teach or suggest all of the limitations of claim 6. Claim 6 and all claims dependent therefrom are, therefore, patentable over the 35 U.S.C. § 103 rejection of record.

Claim 9, recites:

determining optimal tuner power consumption from knowledge of the signals being processed by the tuner; and
adjusting the tuner power consumption in accordance with said determining step, wherein said adjusting step includes the step of adjusting power consumption of certain tuner components within said tuner to achieve a desired intercept point for each component of said certain tuner components.

Accordingly, the invention of claim 9 provides for determining optimal tuner power consumption from knowledge of signals being processed and adjusting the tuner power consumption in accordance with the determined optimal tuner power consumption. As the Applicant demonstrated in the Previous Response, the combination proposed by the Examiner does not teach the invention of claim 9, instead the resulting combination would merely provide a system in which portions of the signal band will be equalized independent from de-energizing a CATV tuning section when a UHF mode selector switch is activated. Nothing in this combination teaches or suggests adjusting tuner power consumption by adjusting power consumption of certain components from knowledge of the signals being processed by the tuner, as required by claim 9.

In addition, claim 9 recites adjusting power consumption of components to achieve a desired component intercept point, which the Examiner's proposed combination also fails to teach. As demonstrated in the Previous Action, the portion of *Caporizzo* relied upon by the Examiner to disclose adjusting a number of components which are active, in actuality merely teaches using a filter to remove various frequency components from the signal, see column 4, lines 15-17. In addition, nothing in the disclosure of *Caporizzo* or *Yamashita* appears to teach or suggest adjusting tuner component power levels to achieve a desired intercept point, at all. Thus, the combination the Examiner proposes fails to teach or suggest these limitations of claim 9 as well. Accordingly, claim 9 and the claims dependent therefrom are asserted to be patentable under 35 U.S.C. § 103.

Similar to claim 9 discussed above, claim 18 recites:

a circuit for determining acceptable tuner power consumption from knowledge of the signals being processed by the tuner; and

at least one circuit for adjusting the tuner power consumption in accordance with said determining circuit, wherein said adjusting circuit adjusts the power consumption of certain tuner components within said tuner.

Accordingly, the invention of claim 18 provides for determining acceptable tuner power consumption from knowledge of signals being processed and adjusting the tuner power consumption in accordance with the determined optimal tuner power consumption. The Applicant again respectfully asserts, that the combination the Examiner proposes merely provides a system in which portions of the signal band will be equalized independent from de-energizing a CATV tuning section when a UHF mode selector switch is activated. There is nothing in this combination that teaches or suggests adjusting tuner power consumption by adjusting power consumption of certain components from knowledge of the signals being processed by the tuner, as required by claim 18.

Moreover, claim 18 recites adjusting certain tuner component power levels. As the Previous Response demonstrated, the portion of *Caporizzo* relied upon by the Examiner to disclose adjusting a number of components which are active, merely teaches using a filter to remove various frequency components from the signal, see column 4, lines 15-17. Thus, the combination the Examiner proposed fails to teach or suggest these limitations of claim 18 as well. Accordingly, claim 18 and the claims dependent therefrom are patentable over the 35 U.S.C. § 103 rejection of record.

Claim 26 recites:

circuitry for determining desired power consumption of certain tuner components from knowledge of signals being processed by the tuner; and

circuitry operable in cooperation with said determining circuitry for adjusting the power consumption of said certain tuner components to achieve a desired component intercept point.

Accordingly, the invention of claim 26 provides for determining desired power consumption of certain tuner components from knowledge of signals being processed and adjusting the power consumption of the tuner components to achieve a desired component

intercept point. Again, the Applicant respectfully asserts that the proposed combination fails to teach or suggest all of the above limitations. For even if one of ordinary skill in the art were to modify the power-up equalization technique of *Caporizzo* to include the tuning section de-energizing technique of *Yamashita*, as the Examiner proposes, the resulting combination would merely provide a system in which portions of the signal band will be equalized independent from de-energizing a CATV tuning section when a UHF mode selector switch is activated. Further, nothing in the disclosure of *Caporizzo* or *Yamashita* teaches or suggests adjusting tuner component power levels to achieve a desired component intercept point. Accordingly, claim 26 and the claims dependent therefrom are asserted to be patentable under 35 U.S.C. § 103.

In response to the arguments above, the Examiner opines in the Current Action that “the mere fact that applicant has recognized another advantage, which would, [sic] flow naturally from the following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” However, the Applicant respectfully points out that the Previous and Current Response do not, and did not, contend that claims 6, 9, 18, and 26 are patentable solely because the Examiner’s proposed combination fails to recite all of the advantages embodied by these claims. Instead, the Applicant has asserted, and does so again, that claims 6, 9, 18, and 26 are patentable because the Examiner’s proposed combination fails to teach or suggest all the limitations of these claims; an assertion unchallenged in the Current Action. Because claims 6, 9, 18, and 26 and the claims dependent therefrom recite limitations not taught by the combination, M.P.E.P. § 2134 concludes that they are patentable over the 35 U.S.C. § 103 rejections of record, and the Applicant respectfully asks the Examiner to withdraw those rejections.

C. Proper Motivation to Combine *Caporizzo* and *Yamashita* has Not Been Provided

In the Previous Action, the Applicant also demonstrated that the Examiner did not establish a proper motivation for combining *Caporizzo* and *Yamashita*, because merely stating that references can be combined or modified does render the resulting combination obvious unless the prior art also suggests the desirability of the combination. In the Current Action, the Examiner concedes that “obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,” but responds by merely concluding that the combination is proper. The Applicant agrees with the Examiner that proper motivation is required, but must respectfully remind the Examiner that, as yet, the Examiner has not provided any. Because neither the Previous nor the Current Action give a proper motivation for making the combination, the Applicant also reminds the Examiner that no *prima facie* case has been made for rejecting any claim under 35 U.S.C. § 103(a).

D. The Dependent Claims

Each of dependent claims 3-6, 8, 10-13, 15-17, 19-22, 24, 25, 27, 29-31, and 33-37 depend directly or indirectly from claim 1, 6, 9, 18, 26, and 32. Applicant has shown how each of independent claims 1, 6, 9, 18, 26, and 32 are patentable over the applied art. It is respectfully asserted that, at least for the reasons set forth above with respect to the independent claims, that dependent claims 3-6, 8, 10-13, 15-17, 19-22, 24, 25, 27, 29-31, and 33-37 are allowable over the applied art. Moreover, these dependent claims present new and non-obvious limitations not shown in the applied art.

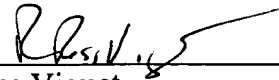
III. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 49581/P016US/09806411 from which the undersigned is authorized to draw.

Dated: April 13, 2004

Respectfully submitted,

By 

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